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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/586,432

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Stephan Zollner

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27386

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06/02/2011

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EXAMINER

ZIMMER, MARC S

ART UNIT

PAPER NUMBER

1765

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/586,432	<b>Applicant(s)</b> ZOLLNER ET AL.	
	<b>Examiner</b> MARC ZIMMER	<b>Art Unit</b> 1765	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-25 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/16/06</u> .  | 6) <input type="checkbox"/> Other: _____                          |

***Claim Rejections - 35 USC § 112***

Claims 13 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner did not see any support in the original Specification for those embodiments of the claimed invention where the crosslinker is an isocyanate- or epoxide compound. This matter is easily remedied by inserting the omitted subject matter into the Specification since the claims constitute part of the original disclosure.

***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 and 7-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Storbeck et al., WO 02/34854.

To the extent that it evolved from a National stage application of the aforementioned international disclosure, U.S. Patent # 7,833,576 is believed to have an identical disclosure and is used as a faithful translation of the WIPO document into the English language. All citation of teaching location will be those for the U.S. publication.

Applicant is no doubt quite familiar with the teachings of this reference given that there the prior art disclosure and instant disclosure share an inventor in common. Thus, the Examiner will not go into significant details regarding its teachings. Rather, Applicant is pointed to the following passages where the vast majority of the claim limitations are addressed. See column 2, line 52 through column 3, line 22, column 2, lines 30-43, column 3, line 65 through column 4, line 1, column 4, lines 6-7, column 4, line 57 through column 5, line 5, and Table 6.

One aspect of instant invention not disclosed in the prior art is the employment of ultraviolet light as an energy source for curing. On the other hand, unsaturated monomers bearing photoinitiator moieties are disclosed in column 3, line 42 and, hence, UV promoted curing that follows polymerization is at least strongly implied, if not expressly indicated. Therefore, the Examiner believes that rejection under both sections 35 U.S.C. 102 and 35 U.S.C. 103 is merited and appropriate. (The Examiner considered the possibility that the utilization of these compounds was taught as a means of facilitating the initial polymerization but there are initiators mentioned elsewhere, column 4, lines 28-30, to promote this step. Also, to the extent that a subsequent crosslinking stage is disclosed involving di- or polyfunctional acrylates as crosslinkers, the exploitation of the aforementioned photoinitiator-containing monomers

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in concert with ultraviolet light at the suitable wavelength at the crosslinking stage would have been obvious to the skilled artisan.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 and 7-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Storbeck et al., WO 02/34854 in view of Olson et al., U.S. Patent # 6,663,978. To reiterate, there is no express disclosure of any energy source for promoting crosslinking other than electron beams. Olson illustrates that the skilled artisan recognizes ultraviolet light and electron beams to be equivalent alternative energy sources for curing acrylic PSA. See column 7, line 21 to column 8, line 11.

This represents merely an additional rationale for rejection.

***Allowable Subject Matter***

Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Daniels et al., U.S. Patent # 6,855,386 is cited as being of interest for their disclosure of an acrylic adhesive that may be hot melt coated wherein the coating apparatus comprises a rotary rod die. The invention disclosed therein parallels that

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which is claimed in most respects but the Examiner could not definitive say that the shrinkback limitation is inherently satisfied without knowing what are all the variables that dictate this property.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC ZIMMER whose telephone number is (571)272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

May 20, 2011

/Marc S. Zimmer/  
Primary Examiner, Art Unit 1765

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